

Appl. No. 10/730,408
Examiner: Zarroli, Michael C, Art Unit 2839
In response to the Office Action dated April 4, 2005

Date: May 17, 2005
Attorney Docket No. 10113441

REMARKS

Responsive to the Office Action mailed on April 4, 2005 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

After entry of this amendment, claims 1 and 4-15 are pending. Claims 1-2 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Rohde (U.S. Patent No. 5,971,790). Claims 3-5 are objected to as being dependent upon a rejected base claim, but are indicated as allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 6-8 are allowed.

In this paper, claim 1 is amended to include all of the limitations of claims 2-3. Claim 4 is amended to depend from claim 1. As the Examiner has indicated that claim 3 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims, it is Applicant's belief that claim 1 is now in condition for allowance. Insofar as claims 4-5 depend from claim 1, it is Applicant's belief that these claims are also in condition for allowance. Claims 2-3 are canceled.

New claims 9-11 and 12-15, depending from allowed claims 6 and 7, respectively, are added. Support for the new claims can be found on pages 2-4 of the specification and in original claims 2-5. As claims 6 and 7 are allowed, Applicant submits that claims 9-15 depending there from either directly or indirectly are also in condition for allowance. Applicant submits that entry of the new claims after final rejection is proper for the reasons set forth in the following section.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

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Prematurity of the Final Office Action Dated April 4, 2004

Applicant submits that the finality of the office action dated April 4, 2004 is premature for at least the reasons as follow.

MPEP 706.07(a) reads in part:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)...

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

Applicant notes that in the office action dated October 5, 2004, claim 2 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Namely, the office action stated that the term "contacting" is a relative term, which renders the claim indefinite. The office action further stated that claim 2 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, second paragraph.

The rejection of claim 2 was traversed in the amendment filed on January 5, 2005. Namely, the Applicant argued that, when read in the light of the specification, one of ordinary skill in the art would be able to ascertain with a reasonable degree of precision and particularity the specific area set out and circumscribed by the claim. Applicant further amended claim 1 to improve syntax, changing "so that" to "wherein".

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As the rejection under 35 U.S.C. 112 was withdrawn in the office action dated April 4, 2005, it is apparent that the Examiner found the Applicant's arguments persuasive. However, the Examiner introduced a new ground of rejection of claim 2 under 35 U.S.C. 102(b) over Rohde. With respect to the final rejection of claim 2, the office action states the following on page 3:

This claim can now be rejected because of the applicant's satisfaction of the 112 rejection of the first office action.

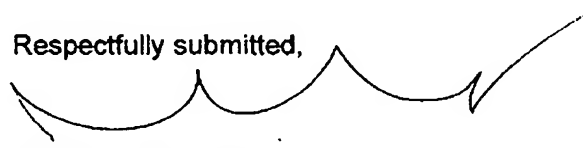
Applicant submits that the rejection of claim 2 over Rohde is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). In the first place, claim 2 was not amended to overcome the rejection under 35 U.S.C. 112. Rather, the rejection was traversed by argument. In addition, Rohde was previously considered in the application; specifically, Rohde was used to reject claim 1 in the office action dated October 5, 2005. Rohde was not submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

For at least these reasons, it is Applicant's belief that the finality of the office action dated April 4, 2005 is premature. Applicant respectfully requests withdrawal of the finality of the office action and entry of new claims 9-15.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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